



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,201	08/02/2001	Gregory Maurice Plow	STL920000037US1	1396

7590 02/08/2005

John L. Rogit
Rogitz & Associates
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,201

Applicant(s)

PLOW ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-16,19-26 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-16,19-26 and 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-5, 8-16, 19-26 and 29-31 have been examined. Application 09/922,201 (SYSTEM, METHOD, AND COMPUTER PROGRAM PRODUCT FOR SELECTIVELY DISPLAYING INTERNET ADVERTISEMENTS) has a filing date 08/02/2001.

Response to Amendment

2. In response to Office Action filed 11/03/04, the Applicant filed a request of reconsideration.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8-10, 30 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory

Art Unit: 3622

subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer-implemented method) within the recited steps of the claimed method of selectively displaying Internet advertisements. The recited steps constitute an idea on how to allow a user to choose at least one advertisement channel or category.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for displaying advertisements at least partially based on channels selected by the user.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 1-5, 8-10, 30 and 31 are deemed to be directed to non statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3622

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 9, 11-16, 19-20, 22-26 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al (U.S. 5,913,040).

As per claim 1, Rakavy teaches:

A computer-method for selectively displaying Internet advertisements, comprising the acts of:

allowing a user to choose at least one advertisement channel from an advertisement channel menu presenting plural advertisement channels and displaying advertisements at least partially based on what channel is selected by the user (see column 3, lines 1-44; column 9, line 15 – column 10, line 12).

As per claim 2, Rakavy teaches:

The method of Claim 1, further comprising the act of allowing the user to create an advertisement window in which advertisements are displayed (see column 11, lines 45-59).

As per claim 3, Rakavy teaches:

The method of Claim 1, further comprising the act of: displaying a menu of user definable advertising attributes (see column 9, lines 15-50; column 10, lines 21-40).

As per claim 4, Rakavy teaches:

The method of Claim 3, further comprising the act of:

allowing the user to establish the values of the user definable attributes (see column 7, lines 42-67).

As per claim 5, Rakavy teaches:

The method of Claim 3, wherein the user definable attributes include at least one of: city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only (see column 7, lines 42-62; column 9, lines 15-50).

As per claim 8, Rakavy teaches:

The method of Claim 1, further comprising the act of displaying at least one advertisement corresponding to a user selected advertisement channel (see column 11, lines 45-57).

As per claim 9, Rakavy teaches:

The method of Claim 1, wherein the advertisement channels menu includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel (see column 9, lines 34-40).

Claim 11 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 12 contains the same limitations as claim 1 therefore the same rejection is applied.

Claim 13 contains the same limitations as claim 3 therefore the same rejection is applied.

Claim 14 contains the same limitations as claim 4 therefore the same rejection is applied.

Claim 15 contains the same limitations as claim 5 therefore the same rejection is applied.

Claim 16 contains the same limitations as claim 6 therefore the same rejection is applied.

Claim 19 contains the same limitations as claim 9 therefore the same rejection is applied.

Claim 20 contains the same limitations as claim 2 therefore the same rejection is applied.

Claim 22 contains the same limitations as claim 12 therefore the same rejection is applied.

Claim 23 contains the same limitations as claim 13 therefore the same rejection is applied.

Claim 24 contains the same limitations as claim 14 therefore the same rejection is applied.

Claim 25 contains the same limitations as claim 15 therefore the same rejection is applied.

Claim 26 contains the same limitations as claim 16 therefore the same rejection is applied.

Claim 29 contains the same limitations as claim 19 therefore the same rejection is applied.

Claim 30 contains the same limitations as claim 2 therefore the same rejection is applied.

Claim 31 contains the same limitations as claims 5 and 8 therefore the same rejection is applied.

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al (U.S. 5,913,040) in view of Smith (U.S. 6,615,248).

As per claim 10, Rakavy teaches:

The method of Claim 1, but fails to teach wherein the advertisements are displayed at a device that receives Internet content and television broadcast content. Smith teaches a system that displays television programs and Internet content in a user's browser (see figures 4 and 5; column 7, lines 25-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rakavy would use the system taught by Smith, to display television programs and Internet information in a browser. This feature would allow users to view television programs, while simultaneously searching for information via the Internet.

Claim 21 contains the same limitations as claim 10 therefore the same rejection is applied.

Response to Arguments

5. Applicant's arguments filed 11/14/04 have been fully considered but they are not persuasive. The Applicant argues that Claim 1 and 30 recite a computer-implemented method and therefore recite statutory subject matter. The Applicant further argues that the preamble of claims 1 and 30 are tied to the respective claim bodies by the recited

"advertisements" in both, therefore, making the claims statutory. The Examiner answers that the advertisements recited in the bodies of the claims are not necessary the same as the advertisements recited in the preamble because there is no phrase that indicates that they are linked. The instant claims fail to recite the use of any type of technology (e.g. computer-implemented method) within the recited steps of the claimed method of selectively displaying Internet advertisements. The Applicant needs to include some type of technology (computer-implemented) into the bodies of the claims to overcome the Section 101.

The Applicant argues that Rakavy does not teach advertising channels, much allowing a user to choose a channel from a menu presenting plural advertisement channels, as recited in claim 1. The Examiner answers that according to the Applicant's specification advertisement channels are advertisements categories (see page 3). Rakavy allows a user to select an advertisement category and displaying in a window advertisements at least partially based on the selected advertisements categories, as taught by Applicant's claimed invention.

The Applicant argues that there are no apparent channels at all in Rakavy because in Rakavy the advertisements may be downloaded from a Web server on a single channel, or the entire database of advertisements is stored on a CD-ROM. The Examiner answers that Applicant's specification page 3 teaches "Also, in a preferred embodiment, a menu of advertisement channels is displayed. A user is allowed to choose an advertisement channel from the menu. Advertisements that correspond to the advertisement channel are then displayed. On the other hand, advertisements that

Art Unit: 3622

do not correspond to the advertisement channel are filtered out of the advertisements transmitted to the user computer. The advertisement channels can include: a travel channel, a food channel, an automotive channel, a clothing channel, a music channel, a movie channel, an antiques channel, a hardware channel, a sporting goods channel, a housewares channel, an art supplies channel, etc. Preferably, a user is allowed to create an advertisement window in which the advertisements are displayed". Rakavy teaches "User preference information typically includes: a) Listings of advertisement categories which are to be given high priority, and those categories which are to be banned from being downloaded or displayed. Typical advertisement categories are "SCUBA diving equipment", "Fast food vendors" "Toys for ages 8-14," or "Cigarettes" and the like. The actual list of categories will be provided by the Advertising System Server 600" (see column 9, lines 35-41). Therefore, the Examiner answers that the Applicant's advertisements channels are a list of advertisements' categories. A user would be allowed to select at least one category from the list to determine the type of advertisements that would be displayed in the user's advertisement window based upon said selection, as taught by Rakavy (see column 9, lines 15-40; column 11, lines 50-55). The Applicant's advertisement channels are not television channels or broadcast channels but a list of advertisements categories, as taught by the Applicant's specification.

The Applicant further argues that Rakavy enables a user to choose particular categories of advertisements but not from an advertisement history window. Applicant's Claim 2 recites "allowing the user to create an advertisement window in which

advertisements are displayed” and claim 30 recites “selecting at least one attribute in an advertising window for displaying advertisements and viewing in an advertising window at least one of a series of advertisements corresponding to a selected attribute”. The window recited in the claims is the window, which would be used to display the advertisements but the said window is not an advertisement history window.

The Applicant is arguing about features that are not in the claims when he argues that Rakavy only mentions “dialog boxes” as the only particularly specified method of entry. Applicant’s claim 1 recites “allowing a user to choose at least one advertisement channel from an advertisement channel menu” and claim 30 recite “selecting at least one attribute in an advertising window for displaying advertisements”. Nowhere in the claims is recited a specific method of entry.

The Applicant further argues that once the desired categories of advertisements are selected in Rakavy, the user is more or less finished. Therefore, the Applicant argues that there are no channels at all in Rakavy. The Examiner answers that according to the Applicant’s specification advertisements channels are advertisements categories (see page 3). Rakavy allows a user to select an advertisement category and displaying in a window advertisements at least partially based on the selected advertisements categories, as taught by Applicant’s claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
January 22, 2004

Yeholega Reita
Primary Examiner
AU 3622